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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,468	12/03/2001	Ernst Heinz	0093/00029	3433

26474 7590 01/27/2006

NOVAK DRUCE DELUCA & QUIGG, LLP
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EXAMINER

MCELWAIN, ELIZABETH F

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,468

Applicant(s)

HEINZ ET AL.

Examiner

Elizabeth F. McElwain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/3/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-14, 16-20 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3 and 13, 14, 16-20, 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 8-12 and 24-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The amendment filed November 3, 2005 has been entered.

Claims 1-5, 8-14, 16-20 and 22-29 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

This application contains claims 2, 3, 13, 14, 16-20, 22 and 23 drawn to an invention nonelected with traverse. In addition, claim 1 recites non-elected SEQ ID numbers. A complete reply to the final rejection must include cancellation of nonelected claims and non-elected SEQ ID numbers or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 2, 3, 13, 14, 16-20, 22 and 23 are withdrawn as drawn to non-elected inventions.

Claims 1, 4, 5, 8-12 and 24-29 are elected, to the extent they are drawn to SEQ ID NO: 1. Applicant is reminded of the requirement to cancel non-elected material and non-elected claims.

Claim Rejections - 35 USC § 112

1. The rejection of claim 1 and claims 4-12 and 24-29 in the recitation of “negligible reduction in the enzymatic action” is withdrawn in view of the deletion of this phrase.
2. The rejection of claim 8 as indefinite in that it is unclear what is intended by “functional” is withdrawn in view of the amendment of the claim.
3. The rejection of claims 9 and 10, and claims 11 and 12 as indefinite in the recitation of “oil-producing organism” is withdrawn in view of applicants arguments. However, it is noted

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that as written the claim can be interpreted to read on the claimed process using any organism, given that all known organisms produce oil in some form.

The rejection of claim 26 as indefinite in that it seems to be missing words and does not make sense, is withdrawn in view of the amendment of the claims.

Claims 1, 4, 5, 8-12 and 24-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, as stated in the previous office action.

Applicants' arguments filed November 3, 2005 have been fully considered but they are not persuasive. Applicants assert that with the cloning of cer-1 and cer-3, a representative number of compounds have been disclosed that meet the written description requirement. Applicants argue that the Examiner has not rebutted the presumption of an adequate written description. The Examiner maintains that applicants have not described the specific structural features that are required in a DNA sequence that encodes a polypeptide having delta-6 acetylenase and/or delta-6 desaturase including any sequences encoding a polypeptide having at least 75% homology and having at least 10% of the enzymatic activity of the polypeptide of SEQ ID NO: 2. Therefore, the claimed genus is not described.

4. Claims 1, 4, 5, 8-12 and 24-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, as set forth in the previous office action.

Applicants' arguments filed November 3, 2005 have been fully considered but they are not persuasive. Applicants assert that the specification provides enough guidance to practice the claimed invention, stating that methods for transforming organisms are provided and vectors are disclosed, and transformed plants are created in the examples, and oil is extracted. The Examiner maintains that the specification does not make clear what sequences are used in the examples. The Examiner maintains that the specification does not enable one skilled in the art to make and/or use the claimed invention for the reasons set forth in the last office action.

Conclusion

5. This is a RCE of applicant's earlier Application No. 09/980,468. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (571) 272-0802. The examiner can normally be reached on increased flex time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.


Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

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A handwritten signature in black ink, appearing to read 'Elizabeth F. McElwain'.

Elizabeth F. McElwain, Ph.D.

Primary Examiner

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EFM